

ESTTA Tracking number: **ESTTA302294**

Filing date: **08/21/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92021069
Party	Defendant Pro Football, Inc.
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Date	08/21/2009
Attachments	Harjo Update 8-21-09.pdf (35 pages)(899446 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Registration No. 1,606,810 (REDSKINETTES)
Registered: July 17, 1990

In the matter of Registration No. 986,668 (WASHINGTON REDSKINS & Design)
Registered: June 18, 1974

In the matter of Registration No. 987,127 (THE REDSKINS & Design)
Registered: June 25, 1974

In the matter of Registration No. 1,085,092 (REDSKINS)
Registered: February 7, 1978

In the matter of Registration No. 978,824 (WASHINGTON REDSKINS)
Registered: February 12, 1974

In the matter of Registration No. 836,122 (THE REDSKINS - Stylized Letters)
Registered: September 26, 1967

SUZAN HARJO, RAYMOND
APODACA, VINE DELORIA, JR.,
NORBERT HILL, JR., MATEO
ROMERO, WILLIAM MEAN, AND
MANLEY BEGAY, JR.

Cancellation No. 92/021,069

Petitioners,

v.

PRO-FOOTBALL, INC.

Registrant.

_____ /

REGISTRANT'S STATUS UPDATE AS TO THE APPEAL OF THIS CASE

Registrant Pro-Football, Inc. ("Registrant") respectfully submits this status update to inform the Board that Petitioners have filed with the Supreme Court of the United States an Application for an Extension of Time Within Which to File a Petition for a Writ of *Certiorari* to

the United States Court of Appeals for the District of Columbia Circuit. In their application, Petitioners request that their deadline to file a petition of writ of *certiorari* to review the judgment of the United States Court of Appeals for the District of Columbia be extended until September 14, 2009. (See Exhibit A attached hereto.)

In view of the above, the instant matter should remain suspended until *certiorari* review, if any, has been completed.

Dated: New York, New York
August 21, 2009

Quinn Emanuel Urquhart Oliver & Hedges, LLP

By: 

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ATTORNEYS FOR REGISTRANT

EXHIBIT A

IN THE SUPREME COURT OF THE UNITED STATES

App. No. _____

SUZAN S. HARJO, ET AL., APPLICANTS

v.

PRO-FOOTBALL, INC.

APPLICATION FOR AN EXTENSION OF TIME WITHIN WHICH TO FILE A PETITION
FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA CIRCUIT

To the Honorable John G. Roberts, Jr., as Circuit Justice for the United States Court of Appeals
for the District of Columbia Circuit:

Applicants respectfully request a 30-day extension of time, to and including September 14, 2009, within which to file a petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the District of Columbia Circuit in this case. The Court of Appeals issued its final opinion on May 15, 2009, and Applicants did not petition for a rehearing *en banc*. Absent an extension, the time within which to file a petition for a writ of certiorari will expire on August 13, 2009. Applicants file this Application at least ten (10) days before that date and copies of the Court of Appeals' May 15, 2009, and July 15, 2005 opinions are attached as Exhibits A and B, respectively, pursuant to S. Ct. R. 13.5. This Court would have jurisdiction over the judgment of the D.C. Circuit pursuant to 28 U.S.C. § 1254(1).

1. On April 2, 1999, the Trademark Trial and Appeal Board ("TTAB") issued an order scheduling the cancellation of Pro-Football, Inc.'s ("Pro-Football") "redskins" marks. The

TTAB's order, issued in response to Applicants' petition pursuant to Section 1064(3) of the Lanham Act (the "Act"), was based on its finding that "the derogatory connotation of the word 'redskin(s)' in connection with Native Americans extends to the term "Redskins," as used in [Pro-Football's] marks" *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1748 (T.T.A.B. 1999) (interpreting Section 2(a) of the Lanham Act).

2. On June 1, 1999, Pro-Football filed a civil action in the United States District Court for the District of Columbia seeking review of the TTAB decision pursuant to 15 U.S.C. § 1071(b)(1). The parties filed cross-motions for summary judgment. Applicants asked the District Court to, *inter alia*, affirm the TTAB's decision and dismiss Pro-Football's laches claim. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 102 (D.D.C. 2003). Pro-Football challenged the TTAB's disparagement finding and argued that Applicants' claims were barred by the doctrine of laches. *Id.*

In an opinion dated September 30, 2003, the District Court granted Pro-Football summary judgment. The court ruled that the doctrine of laches precluded consideration of Applicants' claims and that the TTAB's decision was "not supported by substantial evidence." *Id.* at 145. Applicants appealed the District Court's decision to the Court of Appeals for the District of Columbia Circuit.

3. On July 15, 2005, the Court of Appeals issued an opinion holding that the doctrine of laches was applicable to Applicants' claims, but that the District Court had misapplied the doctrine. *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 48, 367 U.S. App. D.C. 276 (CA DC 2005). The Court of Appeals retained jurisdiction over the case while remanding to the

District Court for the purpose of evaluating whether laches barred Applicant Mateo Romero's claim. *Id.* at 50.¹

The District Court reexamined Applicant Romero's claim in light of the Court of Appeals decision and, on June 25, 2008, issued an opinion finding that his claim was barred by the doctrine of laches. *Pro-Football, Inc. v. Harjo*, 567 F. Supp. 2d 46, 47 (D.D.C. 2008). On May 27, 2009, the Court of Appeals affirmed. *Pro Football, Inc. v. Harjo*, 565 F.3d 880, 881 (D.C. Cir. 2009).

4. The Court of Appeals decision has contributed to a split among the circuit courts as to whether the doctrine of laches is applicable to claims brought under Section 2(a) of the Act. Section 14 of the Act provides that a mark may be cancelled at "any time" if it was obtained contrary to Section 2(a). 15 U.S.C. § 1064(3); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 195 (1985) (recognizing that a registration "may be cancelled at any time" if obtained contrary to the provisions of Section 2). In its July 15, 2005 opinion, the Court of Appeals joined the Federal Circuit "in concluding that the statute does not bar the equitable defense of laches in response to section 1064(3) cancellation petitions." *Harjo*, 415 F.3d at 48 (citing *Bridgestone/Firestone Research, Inc. v. Auto. Club De L'Ouest De La France*, 245 F.3d 1359, 1360-61 (Fed. Cir. 2001) (permitting a laches defense to a cancellation petition under section 1064(3))).

These decisions are in conflict with the Third Circuit's holding in *Marshak v. Treadwell*, 240 F.3d 184 (3d Cir. 2001) (Alito, J.). In *Marshak*, the circuit court examined the plain language of the Act, as well as the prior decisions of the TTAB and federal precedents

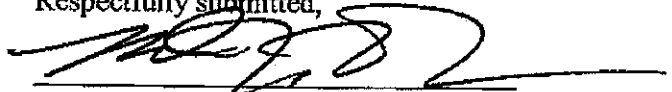
¹ The Court of Appeals denied rehearings before the panel and the *en banc* court regarding this opinion on September 9, 2005. Copies of these orders are attached as Exhibits C and D, respectively.

interpreting the Trademark Act of 1905, and concluded that defenses such as statutes of limitations and laches are not available in response to claims brought under Section 1064(3) of the Act. *Id.* at 192-94. The Federal and D.C. Circuits failed to undertake the thorough analysis conducted by the Third Circuit in *Marshak*.

5. Lead counsel for Applicants had heart surgery on July 23, 2009 and is currently recovering. The additional time sought in this Application is needed to allow lead counsel to recover so that he may consult with undersigned counsel regarding the consideration and preparation of the petition for a writ of certiorari. Lead counsel has intimate knowledge of the record in this case and his input is important to the vigorous representation of Applicants' interests.

For the foregoing reasons, the time to file a petition for a writ of certiorari in this matter should be extended thirty (30) days to and including September 14, 2009.

Respectfully submitted,



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Exhibit A

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Decided May 15, 2009

No. 03-7162

PRO FOOTBALL, INC.,
APPELLEE

v.

SUZAN S. HARJO, ET AL.,
APPELLANTS

Appeal from the United States District Court
for the District of Columbia
(No. 99cv01385)

*Philip J. Mause and Jeffrey J. Lopez were on the briefs
for appellants.*

*Robert L. Raskopf and Sanford I. Weisburst were on the
brief for appellee.*

*Before: SENTELLE, Chief Judge, HENDERSON and TATEL,
Circuit Judges.*

Opinion for the Court filed by Circuit Judge TATEL.

TATEL, *Circuit Judge*: At bottom, this case concerns whether various trademarks related to the Washington Redskins football team disparage Native Americans within the meaning of the Lanham Trademark Act, § 2, 15 U.S.C. § 1052(a). But that question has since been overshadowed by the defense of laches, the basis on which the district court first entered judgment for the Redskins six years ago. We reversed that decision, finding that the district court had misapplied the law of laches to the particular facts of the case. *Pro-Football, Inc. v. Harjo (Harjo II)*, 415 F.3d 44, 50 (D.C. Cir. 2005). On remand, the district court reconsidered the evidence in light of our instructions and again ruled for the team. *Pro-Football, Inc. v. Harjo (Harjo III)*, 567 F. Supp. 2d 46, 62 (D.D.C. 2008). Now appealing that decision, plaintiffs argue only that the district court improperly assessed evidence of prejudice in applying laches to the facts at issue. Limited to that question, we see no error and affirm.

I.

Because previous opinions have already described the background of this case at length, *see Harjo II*, 415 F.3d at 46–47; *Harjo III*, 567 F. Supp. 2d at 48–51, we provide only the essentials. Appellants, seven Native Americans, filed a 1992 action before the Patent and Trademark Office seeking cancellation of six Redskins trademarks that were, they argued, impermissibly disparaging towards members of their ethnic group. Pro-Football, the Redskins' corporate entity and the owner of the marks, argued to the Trademark Trial and Appeal Board that its long-standing use of the name, combined with plaintiffs' delay in bringing the case, called for application of laches, an equitable defense that applies where there is "(1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense," *Nat'l R.R. Passenger Corp. v. Morgan*, 536 U.S. 101, 121–22 (2002) (internal quotation marks omitted). The

TTAB disagreed, observing that petitioners asserted an interest in preventing "a substantial segment of the population" from being held up "to public ridicule," and that insofar as that interest reached "beyond the personal interest being asserted by the present petitioners," laches was inappropriate. *Harjo v. Pro Football Inc.*, 30 U.S.P.Q. 2d 1828, 1831 (TTAB 1994). Finding on the merits that the marks were indeed disparaging, the TTAB cancelled them, see *Harjo v. Pro Football Inc.*, 50 U.S.P.Q. 2d 1705, 1749 (TTAB 1999), depriving Pro-Football of the ability to pursue infringers.

Pro-Football then exercised its option to dispute this holding by means of a civil action in the United States District Court for the District of Columbia. See 15 U.S.C. § 1071(b)(1), (4) (providing choice between district court action and Federal Circuit appeal). The district court sided with Pro-Football on the laches issue, holding that the 25-year delay between the mark's first registration in 1967 and the TTAB filing in 1992 indeed required dismissal of the action. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 144 (D.D.C. 2003). We reversed. "[L]aches," we said, "attaches only to parties who have unjustifiably delayed," *Harjo II*, 415 F.3d at 49, and the period of unjustifiable delay cannot start before a plaintiff reaches the age of majority, *id.* at 48-49. The youngest plaintiff, Mateo Romero, was only a year old in 1967. Because the correct inquiry would have assessed his delay and the consequent prejudice to Pro-Football only from the day of his eighteenth birthday in December 1984, we remanded the record to the district court to consider, in the first instance, the defense of laches with respect to Romero. *Id.* at 49-50.

On remand in this case, the district court again found the defense of laches persuasive. It held that the seven-year, nine-month "Romero Delay Period" evinced a lack of diligence on Romero's part, *Harjo III*, 567 F. Supp. 2d at 53-56, and following our instructions to consider both trial and economic prejudice, see *Harjo II*, 415 F.3d at 50, it found that that delay harmed Pro-Football, *Harjo III*, 567 F. Supp. 2d at 56-62. Now appealing from that decision, Romero challenges neither the applicability of laches *vel non* nor the district court's finding of unreasonable delay. We thus confine our review to the only question Romero does raise: whether the district court properly found trial and economic prejudice sufficient to support a defense of laches.

II.

Before turning to that question, we must first resolve a preliminary matter flagged but left undecided by our previous opinion: the standard of review. In *Harjo II*, we noted an apparent conflict between *Daingerfield Island Protective Society v. Lujan*, 920 F.2d 32, 38 (D.C. Cir. 1990), and *CarrAmerica Realty Corp. v. Kaidanow*, 321 F.3d 165, 172 (D.C. Cir. 2003), over the standard for reviewing a laches determination made on summary judgment. 415 F.3d at 50. In *Daingerfield*, an appeal from summary judgment, we applied abuse of discretion review, noting the consistent view of the courts that "[b]ecause laches is an equitable doctrine," it is "primarily addressed to the discretion of the trial court." 920 F.2d at 38 (internal quotation marks omitted); see also *Coalition for Canyon Preservation v. Bowers*, 632 F.2d 774, 779 (9th Cir. 1980). By contrast, *CarrAmerica* seems to have reviewed a laches determination *de novo*, see 321 F.3d at 172 ("The District Court held that laches did not apply because it determined that Appellants had suffered no prejudice from Appellee's delay. Upon our *de novo* review, we determine that Appellants did indeed suffer prejudice."), but it is unclear

whether this represented a considered opinion on the appropriate standard for reviewing laches decisions or merely referred to the more general standard that typically applies on summary judgment, *see id.* at 170 (referring to general summary judgment standard). Indeed, both standards are relevant: we review the existence of material facts in dispute or the sufficiency of the evidence to support a legal proposition under the familiar *de novo* summary judgment standard, even while deferring to the district court's considerable discretion on the question of how to apply the equitable principles of laches to the undisputed facts. *See, e.g., Hot Wax, Inc. v. Turtle Wax, Inc.*, 191 F.3d 813, 818-19 (7th Cir. 1999). We are thus bound by precedent to apply abuse of discretion review, at least where, as here, an appellant concedes that "the material facts are not in dispute," Appellants' Reply, Br. 2.

Reviewing the district court's analysis of prejudice in light of its considerable discretion, we see no reason to reverse. The district court carefully followed our instruction to assess both trial and economic prejudice arising from the Romero Delay Period, finding both. Romero now challenges those determinations, and while his arguments are not without merit, the errors alleged cannot overcome our deferential standard of review.

The district court relied primarily on two factors in finding trial prejudice: (1) the death of former Redskins president Edward Bennett Williams during the Romero Delay Period; and (2) the delay period's general contribution to the time lapse from the date of registration. *Cf. Harjo*, 50 U.S.P.Q. 2d at 1773-75 (disparagement is analyzed at the time of registration). According to the district court, both factors limited Pro-Football's ability to marshal evidence supporting its mark: Williams had met with Native American

leaders close to the time of registration to discuss their views, while the nearly eight years of further delay made it more difficult to obtain any other contemporaneous evidence of public attitudes towards the mark. See *Harjo III*, 567 F. Supp. 2d at 56-58. Romero mainly argues that this "lost evidence" would have had minimal value. He believes that Williams' testimony would have reflected only a narrow set of views on the disparaging nature of the Redskins marks, and that any possibility that 1967 attitudes could have been better surveyed at the time of an earlier suit is outweighed by other overwhelming evidence of disparagement. We needn't cast doubt on Romero's view of the evidence to hold that there was no abuse of discretion. The lost evidence of contemporaneous public opinion is surely not entirely irrelevant, and weighing the prejudice resulting from its loss falls well within the zone of the district court's discretion. In reviewing that assessment, we cannot assume that legally relevant evidence possibly available in an earlier action would have lacked persuasive content.

Nor can we fault the district court's evaluation of economic prejudice. Undisputed record evidence reveals a significant expansion of Redskins merchandising efforts and sizable investment in the mark during the Romero Delay Period. Romero believes this investment is irrelevant absent some evidence that Pro-Football would have acted otherwise—by, say, changing the Redskins name—if Romero had sued earlier. But the district court repeatedly rejected this argument, citing the Federal Circuit's holding in *Bridgestone/Firestone Research, Inc. v. Automobile Club*, 245 F.3d 1359, 1363 (Fed. Cir. 2001), that "[e]conomic prejudice arises from investment in and development of the trademark, and the continued commercial use and economic promotion of a mark over a prolonged period adds weight to the evidence of prejudice." See *Harjo III*, 567 F. Supp. 2d at 59. The court

thus thought it sufficient that the team deployed investment capital toward a mark Romero waited too long to attack, whether or not the team could prove that it would necessarily have changed its name or employed a different investment strategy had Romero sued earlier.

This was no abuse of discretion. To be sure, a finding of prejudice requires at least some reliance on the absence of a lawsuit—if Pro-Football would have done exactly the same thing regardless of a more timely complaint, its laches defense devolves into claiming harm not from Romero's tardiness, but from Romero's success on the merits. But in contrast to the defense of estoppel—which requires evidence of specific reliance on a particular plaintiff's silence—laches requires only general evidence of prejudice, which may arise from mere proof of continued investment in the late-attacked mark alone. See *Automobile Club*, 245 F.3d at 1363 (“[S]pecific evidence of ‘reliance’ on the Automobile Club’s silence could relate to proof of estoppel, but it does not apply to laches. When there has been an unreasonable period of delay by a plaintiff, economic prejudice to the defendant may ensue whether or not the plaintiff overtly lulled the defendant into believing that the plaintiff would not act, or whether or not the defendant believed that the plaintiff would have grounds for action.”). We have thus described as sufficient “a reliance interest resulting from the defendant’s continued development of good-will during th[e] period of delay,” and treated evidence of continued investment as proof of prejudice sufficient to bar injunctive relief. *NAACP v. NAACP Legal Def. & Educ. Fund, Inc.*, 753 F.2d 131, 137–38 (D.C. Cir. 1985). Such continued investment was unquestionably present here. The district court thus acted well within our precedent—as well as the precedent of the Federal Circuit, which directly reviews TTAB decisions—in finding economic prejudice on the basis of investments made during the delay

period. The lost value of these investments was sufficient evidence of prejudice for the district court to exercise its discretion to apply laches, even absent specific evidence that more productive investments would in fact have resulted from an earlier suit.

In so holding, we stress two factors. First, as the district court correctly noted, the amount of prejudice required in a given case varies with the length of the delay. "If only a short period of time elapses between accrual of the claim and suit, the magnitude of prejudice required before suit would be barred is great; if the delay is lengthy, a lesser showing of prejudice is required." *Gulf Airborne Instruments, Inc. v. Weinberger*, 694 F.2d 838, 843 (D.C. Cir. 1982). This reflects the view that "equity aids the vigilant and not those who slumber on their rights," *NAACP*, 753 F.2d at 137, as well as the fact that evidence of prejudice is among the evidence that can be lost by delay. Eight years is a long time—a delay made only more unreasonable by Romero's acknowledged exposure to the various Redskins trademarks well before reaching the age of majority. *See Harjo III*, 567 F. Supp. 2d at 54-55. The second point follows the first: because laches requires this equitable weighing of both the length of delay and the amount of prejudice, it leaves the district court very broad discretion to take account of the particular facts of particular cases. We have no basis for finding abuse of that discretion where, as here, the claim of error ultimately amounts to nothing more than a different take on hypothetical inquiries into what might have been.

III.

A final issue concerns the trademark of the team's cheerleaders, the "Redskinettes," which Pro-Football first registered in 1990. As to this mark and only this mark, Romero argues that he acted with reasonable diligence by

filing his action in 1992, only 29 months from the mark's registration. The district court disagreed, finding even this short delay unreasonable given the relationship between the Redskinettes claim and the other claims on which Romero was already delaying. *See id.* & 54 n.5. This view followed from Romero's own litigation position. He argued to the district court, this Court, and the TTAB that the disparaging nature of the Redskinettes name derives from the disparaging nature of the Redskins name itself. *See, e.g.,* Appellants' Opening Br. 28 ("In considering the merits of the Redskinettes mark, this Court would necessarily have to examine the TTAB's analysis of the disparagement associated with the term 'redskin' . . ."). The district court thus saw no reason why Romero, fully aware of both the team's name and the cheerleaders' name and six-years into his delay period on the former, failed to complain immediately about the registration of the Redskinettes.

While Romero delayed considerably less in attacking the Redskinettes mark, the district court did not abuse its discretion by analyzing the reasonableness of this delay in light of the delay in bringing the underlying claims regarding the name of the team itself. The Federal Circuit has at least suggested that a defense of laches as to a recently registered mark may be based on a failure to challenge an earlier, substantially similar mark, *see Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 734 (Fed. Cir. 1992), as has the TTAB, *see Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 U.S.P.Q. 585, 590-91 (TTAB 1977). It is unclear to us how this rule interacts with the requirement to analyze disparagement at the time of registration, since the factual context may well have changed. But in any event and in the context of *this* case, it is difficult to see how it could be inequitable to allow Romero to complain about the Redskins but equitable to allow his complaint about the Redskinettes,

particularly because the Redskinettes name had been in use well before the date of registration. Indeed, the registration of the Redskinettes mark reflects perhaps the greatest reliance on the absence of any previous complaints. Thus, without deciding whether Romero could have avoided laches by attacking the Redskinettes mark on the day of registration, we at least see no abuse of discretion in the district court's finding that the 29-month delay evinced a lack of reasonable diligence.

In fact, we think the Redskinettes issue best demonstrates the reasonableness of the district court's approach to this case as a whole. In 1990, six years into the Romero Delay Period, Pro-Football was not only investing in the Redskins mark, but seeking to expand legal protection of related marks; placing greater reliance on the continued validity of its underlying brand name. It would have been bold indeed for the team to have sought to register the Redskinettes under their existing name had the TTAB been considering revocation—or had the TTAB already revoked—the registration of the Redskins mark. We thus think it neither a stretch of imagination nor an abuse of discretion to conclude that Pro-Football might have invested differently in its branding of the Redskins and related entities had Romero acted earlier to place the trademark in doubt. We accordingly have no basis for questioning the district court's determination.

IV.

Deciding only the questions presented, and finding no abuse of discretion in the district court's resolution of them, we affirm.

So ordered.

Exhibit B

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Argued April 8, 2005

Decided July 15, 2005
Reissued September 13, 2005

No. 03-7162

PRO-FOOTBALL, INC.,
APPELLEE

v.

SUZAN S. HARJO, ET AL.,
APPELLANTS

Appeal from the United States District Court
(USDC) for the District of Columbia
(No. 99cv01385)

Philip J. Mause argued the cause for appellants. With him on the briefs was *Norm D. St. Landau*.

Thomas C. Morrison argued the cause for *amici curiae* National Congress of American Indians, et al. in support of appellants. With him on the brief was *Walter Echo-Hawk*.

Adam L. Barea and *Robert R. Vieth* were on the brief for *amicus curiae* InterFaith Conference of Metropolitan Washington in support of appellants.

Robert L. Raskopf argued the cause for appellee. With him

on the brief were *Marc E. Ackerman*, *Carolyn B. Lamm*, and *Francis A. Vasquez, Jr.*

Before: SENTELLE, RANDOLPH, and TATEL, *Circuit Judges*.

Opinion for the Court filed PER CURIAM.

PER CURIAM: In 1992, seven Native Americans petitioned the Trademark Trial and Appeal Board ("TTAB") to cancel the registrations of six trademarks used by the Washington Redskins football team. After the TTAB granted their petition, the team's owner, Pro-Football, Inc., brought suit seeking reversal of the TTAB's decision. The district court granted summary judgment to Pro-Football on two alternate grounds, holding that the TTAB should have found the Native Americans' petition barred by laches and that in any event the TTAB's cancellation decision was unsupported by substantial evidence. The Native Americans now appeal. Because we find that the district court applied the wrong standard in evaluating laches as to at least one of the Native Americans, we remand the record for the district court to revisit this issue.

I.

The Lanham Trademark Act provides protection to trademark owners. *See generally* 15 U.S.C. §§ 1051-1127, 1141-1141n. To take advantage of many of its provisions, trademark owners must register their marks with the Patent and Trademark Office. Not all marks, however, can be registered. Under 15 U.S.C. § 1052, the PTO must deny registration to certain types of marks, including those which, in subsection (a)'s language, "may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."

Another section, 15 U.S.C. § 1064(3), provides that if a

mark is registered in violation of section 1052(a), "any person who believes that he is or will be damaged by the registration" may file a petition "[a]t any time" with the PTO to cancel the registration. This triggers a proceeding before the TTAB, *see* 15 U.S.C. § 1067, which takes evidence and determines whether to cancel the mark. Yet another provision, 15 U.S.C. § 1069, states that "[i]n all . . . proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied."

This case concerns the registrations of six trademarks owned by Pro-Football, the corporate owner of the Washington Redskins football team, that include the word "Redskin." The first—"The Redskins" written in a stylized script—was registered in 1967, three more in 1974, another in 1978, and the sixth—the word "Redskinettes"—in 1990. Pro-Football uses all these marks in connection with goods and services related to its football team, including merchandise and entertainment services.

In 1992, seven Native Americans petitioned for cancellation of the registrations, claiming that the marks had disparaged Native Americans at the times of registration and had thus been registered in violation of section 1052(a). Pro-Football defended its marks, arguing among other things that laches barred the Native Americans' claim. Rejecting this argument, the TTAB found laches inapplicable due to the "broader interest—an interest beyond the personal interest being asserted by the present petitioners—in preventing a party from receiving the benefits of registration where a trial might show that respondent's marks hold a substantial segment of the population up to public ridicule." *Harjo v. Pro-Football Inc.*, 30 U.S.P.Q.2d 1828, 1831 (TTAB 1994).

On the merits, the parties presented the TTAB with a variety of evidence, including (1) dictionary entries for "redskin," some of which contained usage labels identifying the

term as offensive and others of which did not; (2) book and media excerpts from the late nineteenth century through the 1940s that used the term "redskin" and portrayed Native Americans in a pejorative manner; (3) a study that found derogatory use of the term in Western-genre films from before 1980; (4) petitioners' testimony about their views of the term; (5) results from a 1996 survey of the general population and Native Americans that asked whether various terms, including "redskin," were offensive; (6) newspaper articles and game program guides from the 1940s onward using Native American imagery in connection with Washington's football team; and (7) testimony and documents relating to Native American protests, including one in 1972, aimed specifically at the team. In a lengthy opinion, the TTAB concluded that a preponderance of the evidence showed the term "redskin" as used by Washington's football team had disparaged Native Americans from at least 1967 onward. *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705 (TTAB 1999). The TTAB cancelled the registrations. Cancellation did not require Pro-Football to stop using the marks, but it did limit the team's ability to go after infringers under the Lanham Act.

Pursuant to 15 U.S.C. § 1071(b), Pro-Football filed suit in the U.S. District Court for the District of Columbia, seeking reinstatement of its registrations on the grounds that: (1) laches barred the Native Americans' petition; (2) the TTAB's finding of disparagement was unsupported by substantial evidence; and (3) section 1052(a) violates the First and Fifth Amendments to the U.S. Constitution both facially and as applied by the TTAB. Although in suits challenging TTAB decisions parties may introduce new evidence in the district court, *see Material Supply Int'l, Inc. v. Sunmatch Indus. Co.*, 146 F.3d 983, 989-90 (D.C. Cir. 1998), in this case the only such evidence of note related to laches. After discovery, the parties cross-moved for summary judgment. Without reaching the constitutional issues, the district court granted summary judgment to Pro-Football on the

alternate grounds that laches barred the Native Americans' petition and that the TTAB's conclusion of disparagement was unsupported by substantial evidence. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003). This appeal followed.

II.

An equitable doctrine, "[l]aches is founded on the notion that equity aids the vigilant and not those who slumber on their rights." *NAACP v. NAACP Legal Def. & Educ. Fund, Inc.*, 753 F.2d 131, 137 (D.C. Cir. 1985). This defense, which Pro-Football has the burden of proving, see *Gull Airborne Instruments, Inc. v. Weinberger*, 694 F.2d 838, 843 (D.C. Cir. 1982), "requires proof of (1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense." *Nat'l R.R. Passenger Corp. v. Morgan*, 536 U.S. 101, 121-22 (2002) (internal quotation marks omitted). In this case, the Native Americans contend both that the statute bars the defense of laches and that even were laches an available defense, Pro-Football has failed to prove it.

The Native Americans' statutory argument runs as follows: because section 1064(3) permits petitions alleging wrongful registration under section 1052(a) to be filed "[a]t any time," laches is not a valid defense in cancellation proceedings. We disagree. The words "[a]t any time" demonstrate only that the act imposes no statute of limitations for bringing petitions. Those words have nothing to do with what equitable defenses may be available during cancellation proceedings. Indeed, under the Native Americans' logic, equitable defenses would never be available as long as cancellation petitions are brought within the specified statute of limitations—"a]t any time" for petitions alleging wrongful registration under section 1052(a) or certain other grounds, see 15 U.S.C. § 1064(3)-(5), and "[w]ithin five years" of registration for petitions brought for all other reasons, see *id.* § 1064(1). This would make section 1069,

which explicitly permits consideration of laches and other equitable doctrines, meaningless as to cancellation petitions. For this reason, we disagree with the Third Circuit's suggestion that laches is not an available defense to cancellation petitions brought pursuant to section 1064(3), *see Marshak v. Treadwell*, 240 F.3d 184, 193-94 & n.4 (3d Cir. 2001). Instead, we join the Federal Circuit, *see Bridgestone/Firestone Research, Inc. v. Auto. Club de L'Ouest de la France*, 245 F.3d 1359, 1360-61 (Fed. Cir. 2001) (permitting the defense of laches to a cancellation petition brought under section 1064(3)), and our own district court, *see Pro-Football, Inc. v. Harjo*, 57 U.S.P.Q.2d 1140, 1145 (D.D.C. 2000), in concluding that the statute does not bar the equitable defense of laches in response to section 1064(3) cancellation petitions.

The Native Americans also offer several reasons why, in their view, the district court erred in its assessment of laches in this case. At this point, we need only consider one: their claim that the district court mistakenly started the clock for assessing laches in 1967—the time of the first mark's registration—for *all* seven Native Americans, even though one, Mateo Romero, was at that time only one year old.

We agree with the Native Americans that this approach runs counter to the well-established principle of equity that laches runs only from the time a party has reached his majority. The Supreme Court first embraced this principle in 1792, holding in a case dealing with conflicting 1761 land grants that “laches cannot . . . be imputed” as the “rights do not seem to have been abandoned; for in 1761, the children were infants, and were hardly of age, when this action was brought.” *Gander's Lessee v. Burns*, 4 U.S. (4 Dall.) 122 (1792). The Court has since held to this principle. *See Hoyt v. Sprague*, 103 U.S. 613, 636-37 (1880) (evaluating laches “after [complainants] came of age”); *Wetzel v. Minn. Ry. Transfer Co.*, 169 U.S. 237, 240 (1898) (acknowledging “that the minors were not affected by laches

until they became of age"); cf. *Wagner v. Baird*, 48 U.S. (7 How.) 234, 242 (1849) (noting that equity makes allowances for "circumstances to account for [a party's] neglect, such as imprisonment, infancy, coverture, or by having been beyond seas"); 2 Joseph Story, *Commentaries on Equity Jurisprudence, as administered in England and America* 844 n.(b) (photo. reprint 1988) (Melville M. Bigelow, ed., 13th ed. 1886) (stating that "[i]t is not laches to wait until one is in a legal condition to sue"); William MacPherson, *A Treatise on the Law Relating to Infants* 338-39 (Philadelphia, John S. Littel 1843) (observing that "[i]t is a maxim of law that laches is not to be imputed to an infant, because he is not supposed to be cognizant of his rights, nor capable of enforcing them").

Pro-Football asserts that were we to apply this principle here, it "would logically mean that trademark owners could never have certainty, since a disparagement claim could be brought by an as yet unborn claimant for an unlimited time after a mark is registered." Appellee's Br. at 48. At the least, this assertion is overstated—only owners of those trademarks that may disparage a population that gains new members (as opposed to one that disparages, say, a single corporate entity, see, e.g., *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635 (TTAB 1988)), would face such a prospect. But even if registrations of some marks would remain perpetually at risk, it is unclear why this fact authorizes—let alone requires—abandonment of equity's fundamental principle that laches attaches only to parties who have unjustifiably delayed in bringing suit. Pro-Football forgets that "laches is not, like limitation, a mere matter of time," *Holmberg v. Armbrrecht*, 327 U.S. 392, 396 (1946) (internal quotation marks omitted), but rather turns on whether the party seeking relief "delayed inexcusably or unreasonably in filing suit" in a way that was "prejudicial" to the other party, *Rozen v. District of Columbia*, 702 F.2d 1202, 1203 (D.C. Cir. 1983) (per curiam). Why should equity give more favorable treatment to parties that harm

expanding numbers of people (in which case, under Pro-Football's theory, laches runs from the date of harm) than it gives to parties that harm only a few people (in which case laches runs from whenever those people are free of legal disabilities)? Why should equity elevate Pro-Football's perpetual security in the unlawful registration of a trademark over the interest of a Native American who challenged this registration without lack of diligence? Why should laches bar *all* Native Americans from challenging Pro-Football's "Redskins" trademark registrations because *some* Native Americans may have slept on their rights?

The fact that Pro-Football may never have security in its trademark registrations stems from Congress's decision not to set a statute of limitations and instead to authorize petitions for cancellation based on disparagement "[a]t any time." See 15 U.S.C. § 1064(3). Congress knew perfectly well how to set statutes of limitations—as noted earlier, it required that petitions for cancellations on many other grounds be brought "[w]ithin five years" of registration, *id.* § 1064(1)—but consciously declined to do so with respect to cancellation petitions based on disparagement. Indeed, Congress may well have denied companies the benefit of a statute of limitations for potentially disparaging trademarks for the very purpose of discouraging the use of such marks. See *id.* § 1065 (providing that marks "shall be incontestable" after five years "[e]xcept on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064" (emphasis added)); *cf. In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938) (noting that the "field is almost limitless from which to select words for use as trade-marks, and one who uses debatable marks does so at the peril that his mark may not be entitled to registration").

Here, Romero has brought his own claim, and there is no reason why the laches of others should be imputed to him. In

accordance with the context-specific approach required by equity, the district court should have measured both his delay and the resulting prejudice to Pro-Football based on the period between his attainment of majority and the filing of the 1992 cancellation petition.

For several reasons, we prefer not to undertake our own analysis of Romero's laches. The district court never addressed this issue, the parties have briefed it minimally at best, and, most significantly, we may owe deference to the district court's assessment of laches. Compare *Daingerfield Island Protective Soc'y v. Lujan*, 920 F.2d 32, 38 (D.C. Cir. 1990) (conducting abuse-of-discretion evaluation of laches in reviewing a district court's summary judgment ruling), with *CarrAmerica Realty Corp. v. Kaidanow*, 321 F.3d 165, 172 (D.C. Cir. 2003) (conducting de novo evaluation of laches in reviewing a district court's summary judgment ruling). Therefore, we shall remand the record for the district court to evaluate Romero's laches.

In assessing prejudice, the district court should address both trial and economic prejudice. As to trial prejudice, the court should consider the extent to which Romero's post-majority delay resulted in a "loss of evidence or witnesses supporting [Pro-Football's] position," see *Gull Airborne Instruments*, 694 F.2d at 844. As to economic prejudice, we express no view as to how such prejudice should be measured where, as here, what is at stake is not the trademark owner's right to use the marks but rather the owner's right to Lanham Act protections that turn on registration. We encourage the district court to take briefing on whether economic prejudice should be measured based on the owner's investment in the marks during the relevant years, on whether the owner would have taken a different course of action—e.g., abandoned the marks—had the petitioner acted more diligently in seeking cancellation, or on some other measure.

III.

While retaining jurisdiction over the case, we remand the record to the district court for the purpose of evaluating whether laches bars Mateo Romero's claim.

So ordered.

Exhibit C

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 03-7162

September Term, 2005

99cv01385

Filed On: September 9, 2005

[917571]

Pro Football, Inc.,
Appellee

v.

Suzan S. Harjo, et al.,
Appellants

BEFORE: Sentelle, Randolph, and Tatel, Circuit Judges

ORDER

Upon consideration of appellee's petition for rehearing filed August 15, 2005, it is

ORDERED that the petition be denied.

Per Curiam

FOR THE COURT:
Mark J. Langer, Clerk

BY:
Michael C. McGrail
Deputy Clerk

Exhibit D

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 03-7162

September Term, 2005

99cv01385

Filed On: September 9, 2005

[917570]

Pro Football, Inc.,
Appellee

v.

Suzan S. Harjo, et al.,
Appellants

BEFORE:

Ginsburg, Chief Judge, and Edwards,* Sentelle, Henderson,
Randolph, Rogers, Tatel, Garland,* Roberts,* Brown and
Griffith, Circuit Judges

ORDER

Upon consideration of appellee's petition for rehearing en banc, and the absence of a request by any member of the court for a vote, it is

ORDERED that the petition be denied.

Per Curiam

FOR THE COURT:

Mark J. Langer, Clerk

BY:

Michael C. McGrail
Deputy Clerk

* Circuit Judges Edwards, Garland, and Roberts did not participate in this matter.

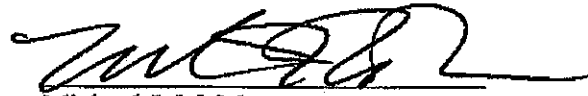
CERTIFICATE OF SERVICE

I hereby certify that on this 30th day of July, 2009, I caused a true and correct copy of the foregoing Application for an Extension of Time Within Which to File a Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit pursuant to Rule 29.5(b) of the Rules of the Supreme Court to be served on the following by first class mail, postage prepaid to the parties listed below:

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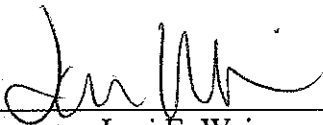
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Michael J. McManus

Certificate of Service

I certify that on the 21st day of August, 2009, I caused a true copy of Registrant's STATUS UPDATE AS TO THE APPEAL OF THIS CASE to be served on Petitioners' attorney, Philip J. Mause, Drinker Biddle & Reath LLP, 1500 K Street, N.W., Suite 1100, Washington, D.C. 20005-1209, via First Class mail.



Lori E. Weiss